



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/350,197 07/08/99 MONROE D 58959.10.23

JUDY KRUGER
BRACEWELL & PATTERSON LLP
711 LOUISIANA STREET
SUITE 2900
HOUSTON TX 77002-2781

WM01/0110

EXAMINER

CUMMING, W

ART UNIT

PAPER NUMBER

2684

DATE MAILED:

01/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/350,197

Applicant(s)

MONROE, DAVID A.

Examiner

WILLIAM D. CUMMING

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 24 objected to because of the following informalities:

The claim is not in a single sentence form. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification inadequately describe and/or fails to originally support the now claimed operation conditions is the determination of whether the transmission is occurring peak or off peak periods as stated by claim 27.

OFFICE ACTION 01/05/01
7:10 PM

4. Claims 8, 27, and 30 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to provide an enabling disclosure on how the wired transmission is an internet connection as stated in claim 8.

The specification fails to provide an enabling disclosure on how the method can determine as one of the operation conditions whether the transmission is occurring during peak or off-peak periods as stated by claim 27.

The specification fails to provide an enabling disclosure on how the connector of supporting an internet, ethernet or LAN connection as stated by claim 30.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

OFFICE ACTION 01/05/01
7:10 PM

6. Claims 1-12, 15, 16, 18-26, 33-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **O'Sullivan**.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

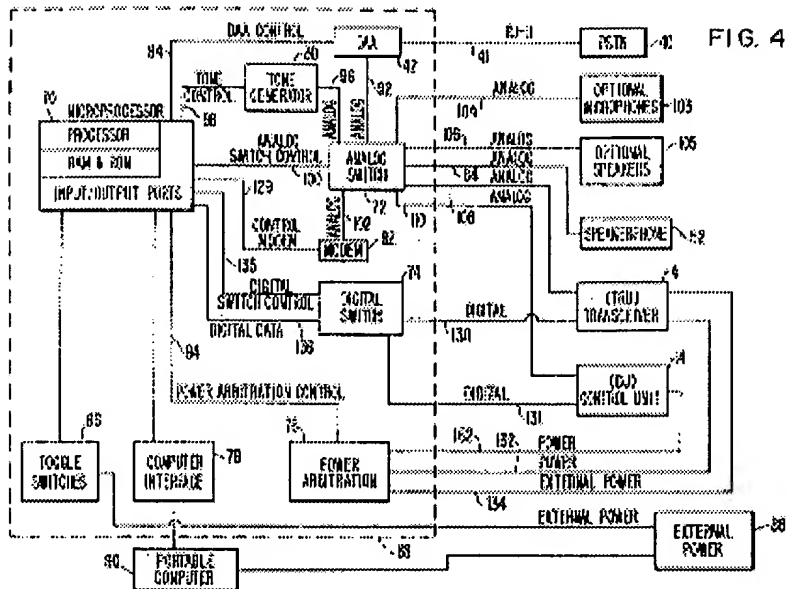
This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be

"essential to point out the invention defined by the claim." Kropa v. Robie, 187

F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



7. Claims 1, 2, 4, 6, 7, 9-17, 25, 26, 28, 29, 33-37, and 43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Gillig, et al.**

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

OFFICE ACTION 01/05/01
7:10 PM

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

OFFICE ACTION 01/05/01
7:10 PM

FIG. 4

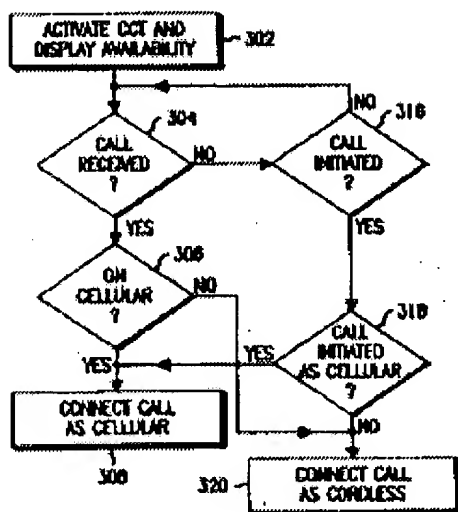
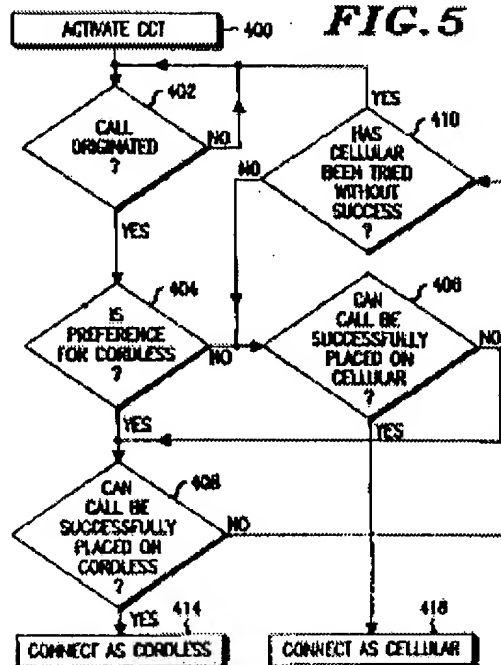


FIG. 5



8. Claims 1, 2, 4, 6, 7, 9-17, 25, 26, 28, 29, 33-37, and 41-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Schellinger, et al**, (United States Patent 5,260,988).

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The

following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

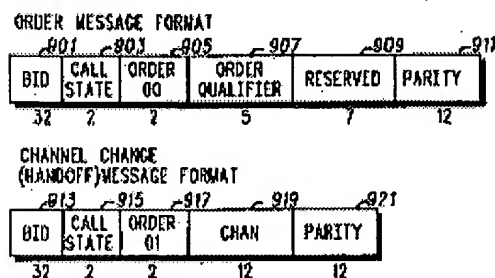


FIG. 9

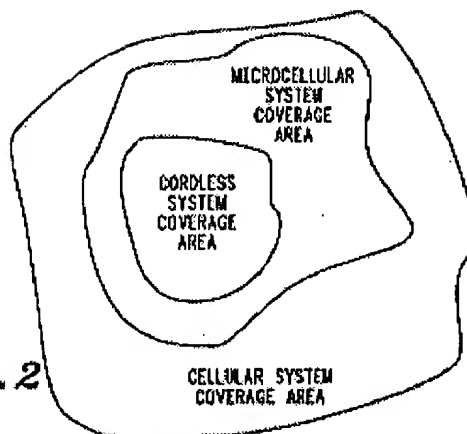


FIG. 2

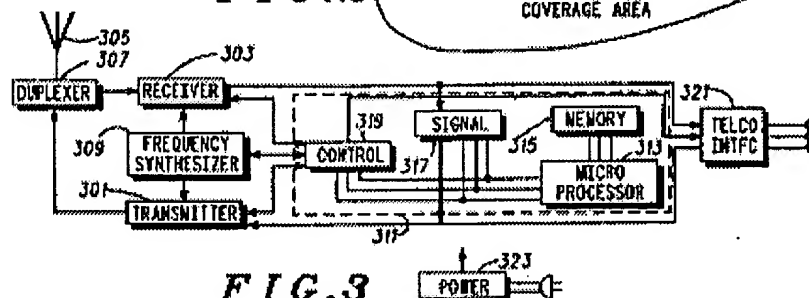


FIG. 3

9. Claims 1-4, 12-17, 23, 26, 28, and 33-36, and 43 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Fyfe, et al.**

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

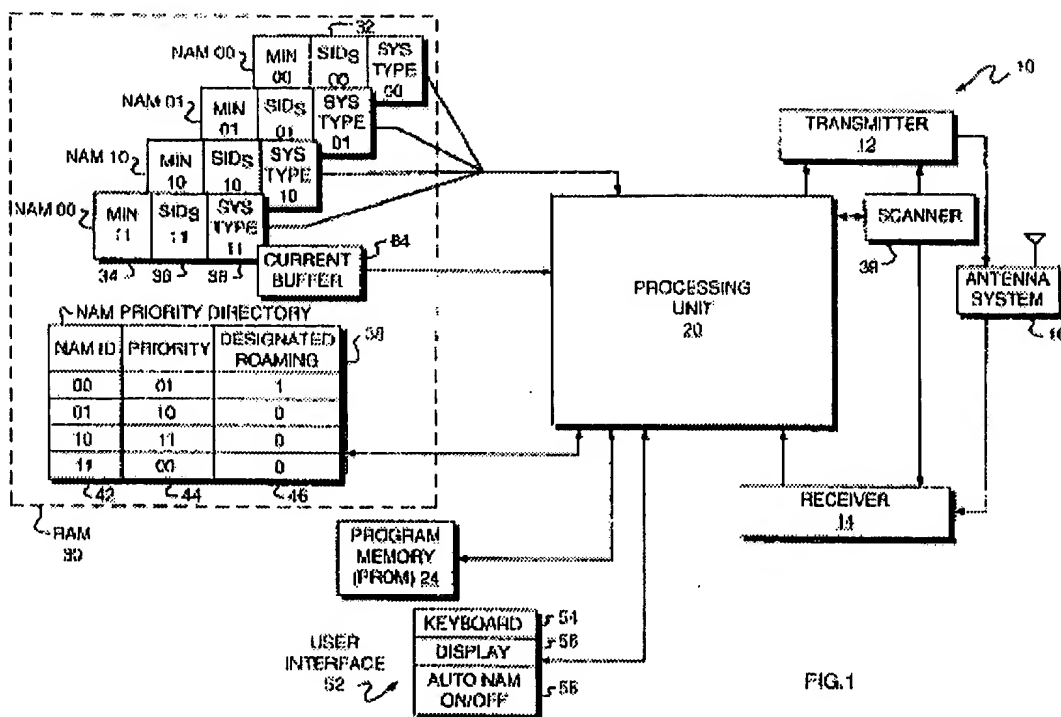
OFFICE ACTION 01/05/01
7:10 PM

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



10. Claims 1-7, 9-19, 22, 25, 26, 28, 33-37, and 39-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Cashman**.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

OFFICE ACTION 01/05/01
7:10 PM

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

OFFICE ACTION 01/05/01
7:10 PM

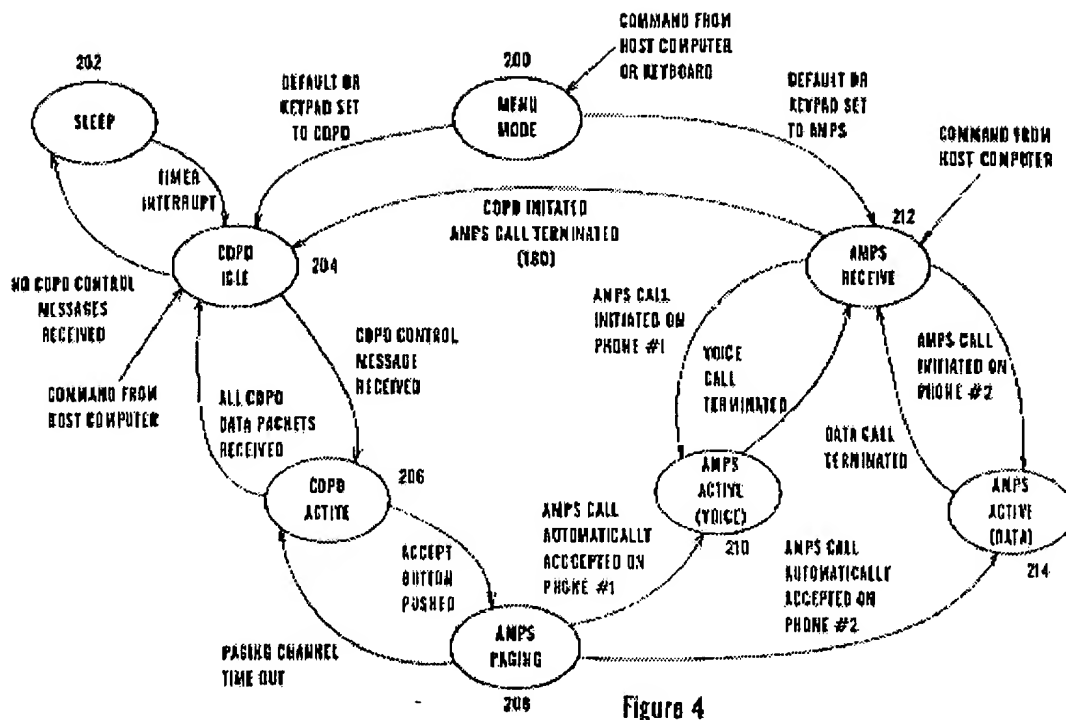


Figure 4

11. Claims 1, 2, 4, 6, 7, 9-17, 25, 26, 28, 29, 33-37, and 41-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Schellinger, et al** (United States Patent 5,842,122).

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The

following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

OFFICE ACTION 01/05/01
7:10 PM

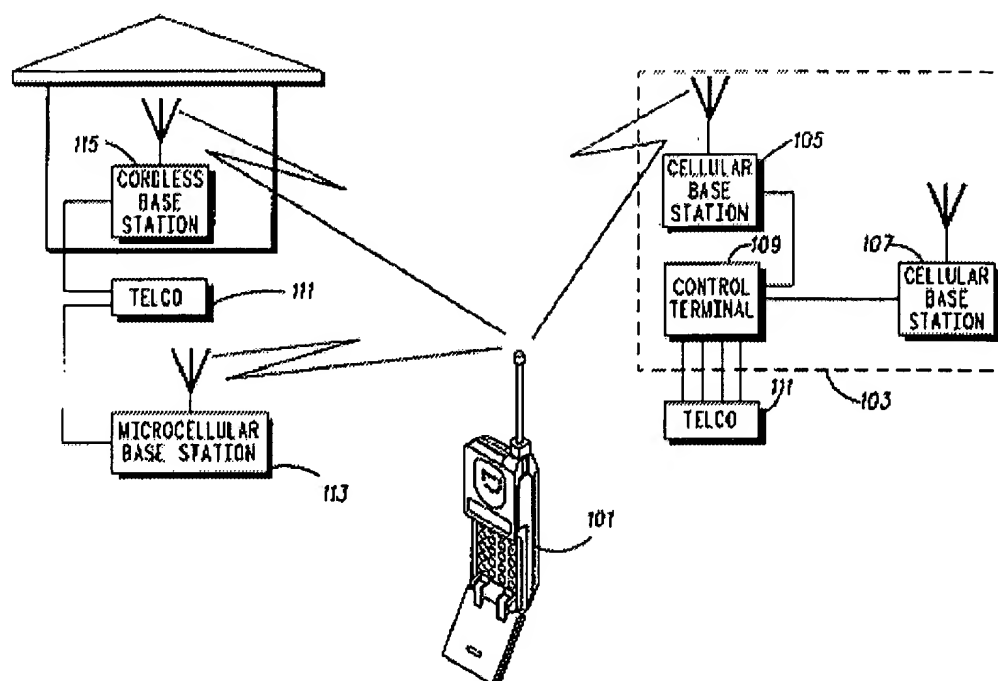


FIG. 1

12. Claims 1-7, 9-17, 22, 23, 25, 26, 28, 33-38, and 42-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Dent**.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

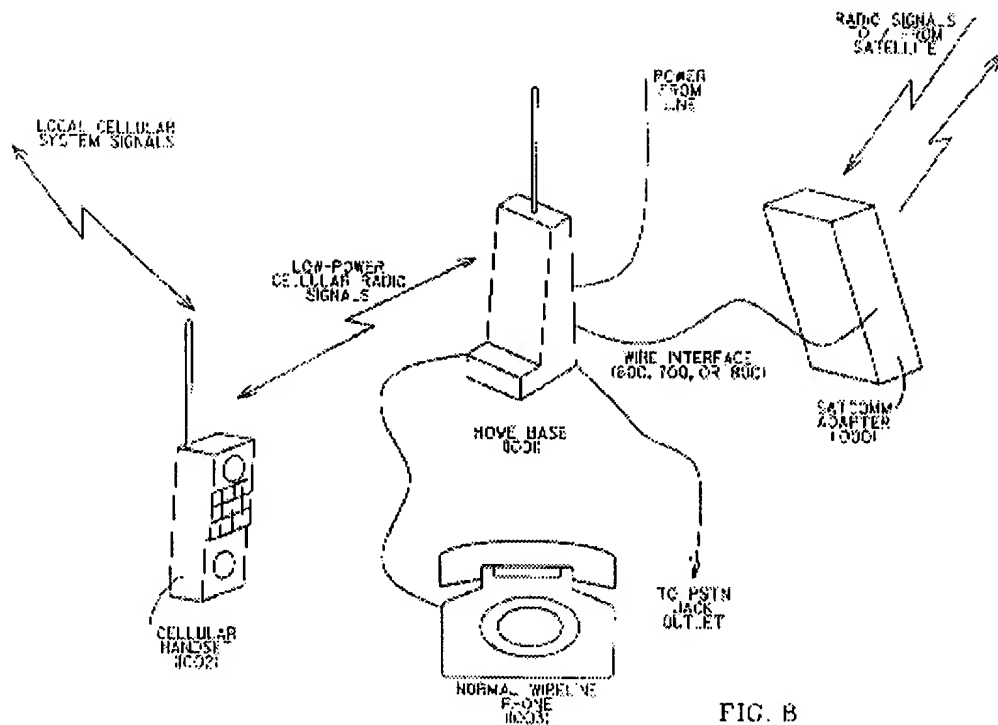
- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

OFFICE ACTION 01/05/01
7:10 PM



13. Claims 1-6, 9-12, 15-26, 28, 33-38, 40, 41, 43, and 44 rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Shimosako**.

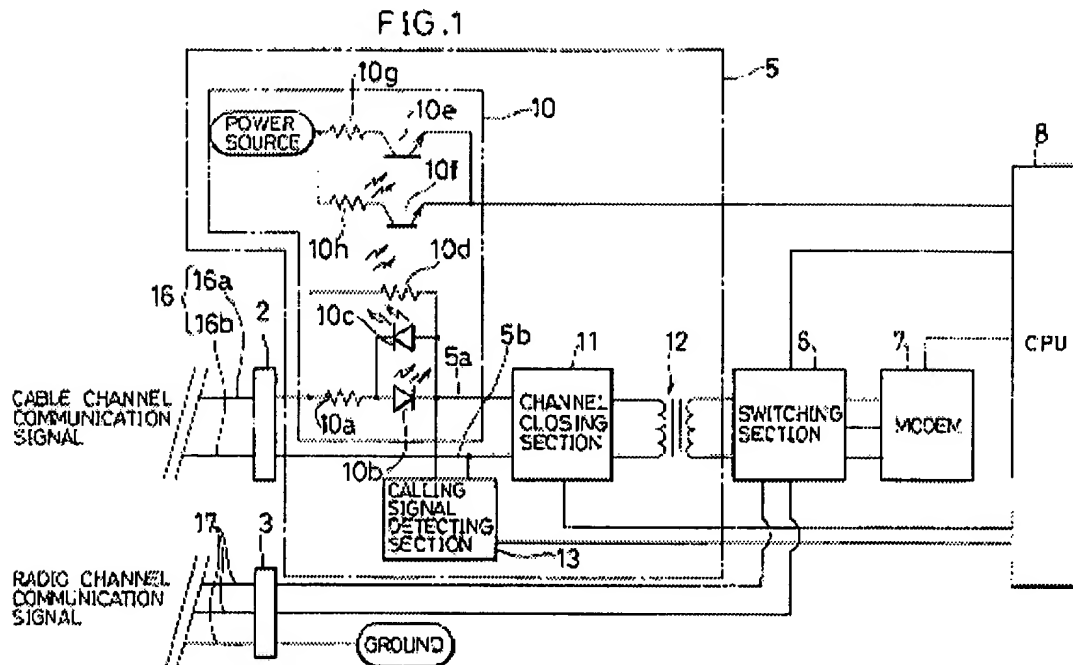
The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



14. Claims 1-20, 22, 24-26, 28, 33-37, 39, 40, 43, and 44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Seazholtz, et al.**

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

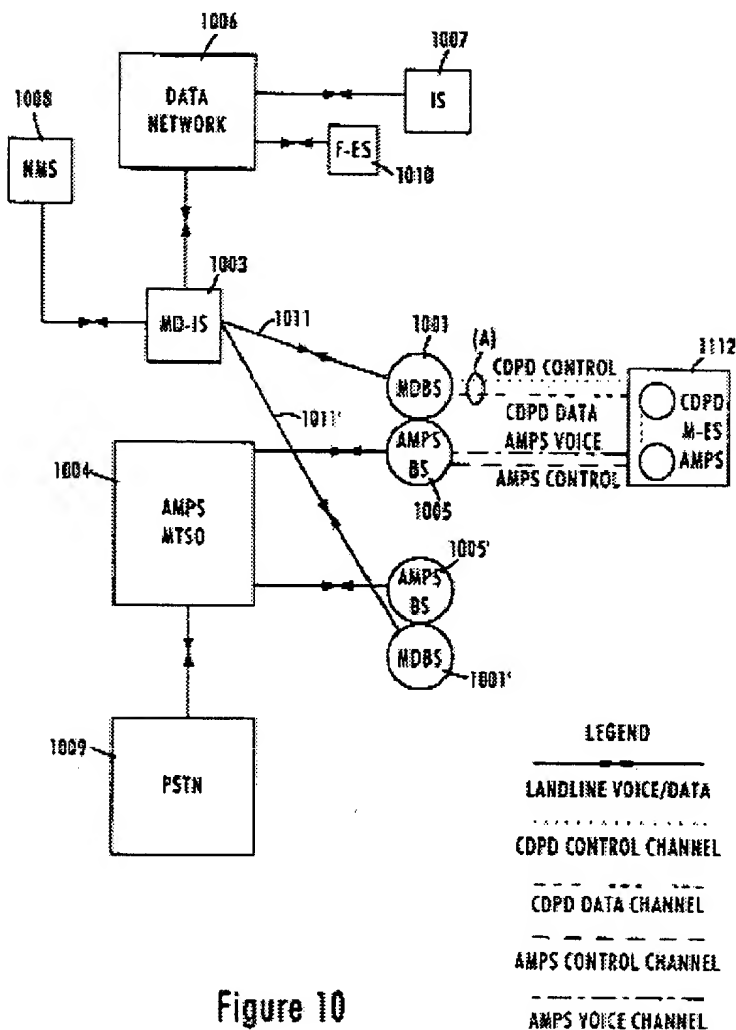


Figure 10

15. Claims 1, 2, 4, 5, 9-17, 26, 28, 33-37, and 41-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Molne**.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate

OFFICE ACTION 01/05/01
7:10 PM

whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

FIG. 3

PRIORITY	INFORMATION FIELD	NODE	POINTER
1	NONE PLMN	PCS1900	SIN (6F07)
2	PREFERRED PLMNs	PCS1900	SIN (6F30)
3	NONE SID	AMPS	SIN (XXXX)
4	ANY OTHER PLMNs	PCS1900	NONE
5	PREFERRED SIDs	AMPS	SIN (YYYY)
6	PREFERRED SIDF (A OR B)	AMPS	SIN (ZZZZ)
7	ANY OTHER AMPS NETWORK	AMPS	NONE

FIG. 4

NODE	POINTER
0	6F07
0	6F30
1	XXXX
0	0000
1	YYYY
1	ZZZZ
1	0000

16. Claims 1-4, 12-17, 23, 26, 33-36, and 43 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Blakeney, II, et al.**

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The

OFFICE ACTION 01/05/01
7:10 PM

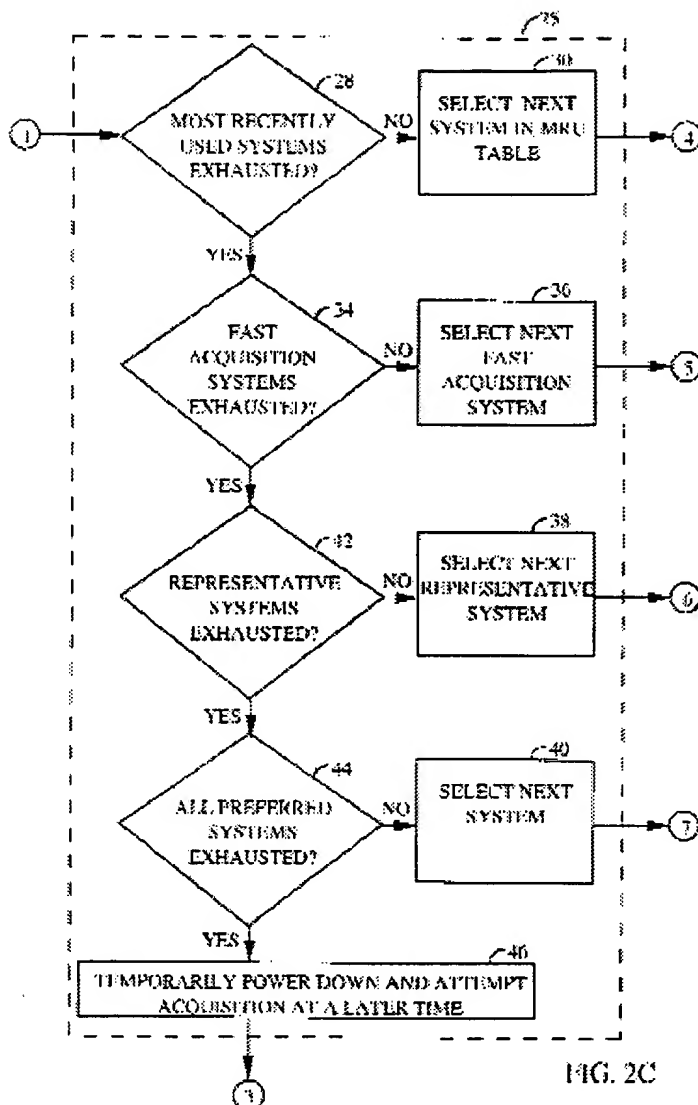
following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).



17. Claims 1-4, 12-17, 23, 26, 33-36, and 43 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Kukkohovi**.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes

OFFICE ACTION 01/05/01
7:10 PM

optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

OFFICE ACTION 01/05/01
7:10 PM

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

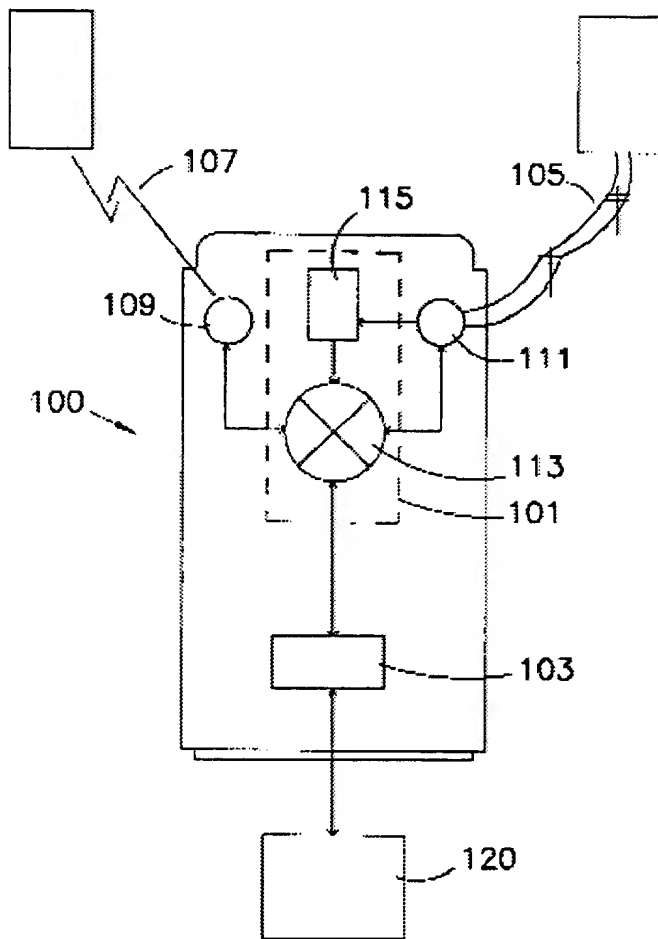


FIG. 1

19. Claims 1-4, 6, 7, 9, 10, 20, 22, 25-28, 33, and 41-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Rabe, et al.**

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes

OFFICE ACTION 01/05/01
7:10 PM

optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “*adapted to*” or “*adapted for*” clauses,
- (C) “*wherein*” clauses, or
- (D) “*whereby*” clauses.

This list of examples is not intended to be exhaustive.

It has been held that the recitation that an element is “*capable of*” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be “*essential to point out the invention defined by the claim.*” *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478,481 (CCPA 1951).

OFFICE ACTION 01/05/01
7:10 PM

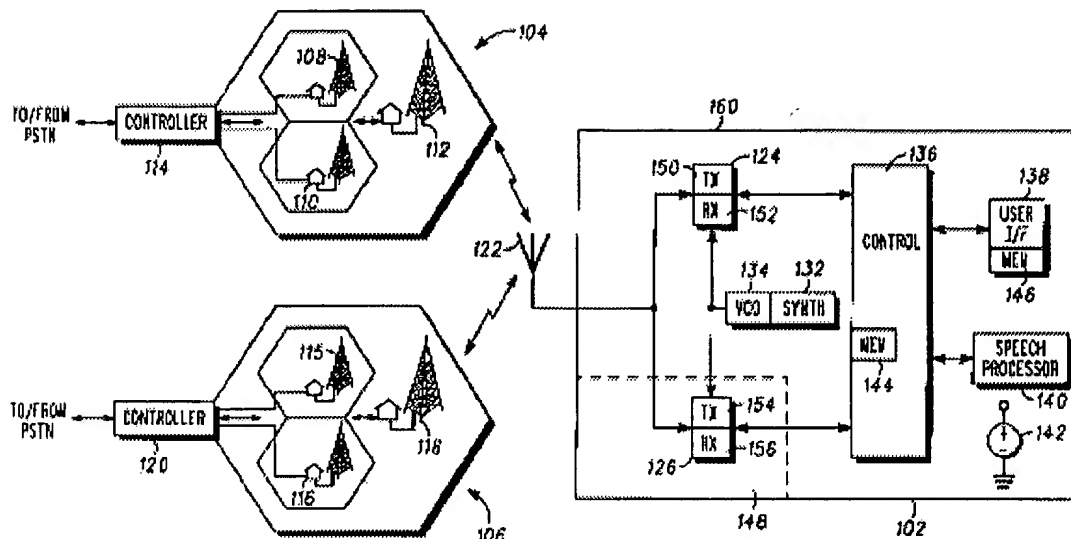


FIG. 1

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
22. Claims 8, 29, 30, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan**.

Liebenow, et al or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan**

disclose all subject matter claimed except for an explicate showing of an Internet connection and standard jacks. The examiner takes Official notice that an Internet connection and standard jacks, like RJ-11, RJ-45, and modular eight-pin jack, are well known in telecommunication systems. Hence, it would have been very obvious at the time the claimed invention was made to incorporate the well known use of of an Internet connection and standard jacks in the method and apparatus of **Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan** in order to access internet service like e-mail and to attach standard telecommunication equipment to the apparatus or to attach the apparatus to standard telecommunication systems.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The

OFFICE ACTION 01/05/01
7:10 PM

following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "*adapted to*" or "*adapted for*" clauses,
- (C) "*wherein*" clauses, or
- (D) "*whereby*" clauses.

This list of examples is not intended to be exhaustive.

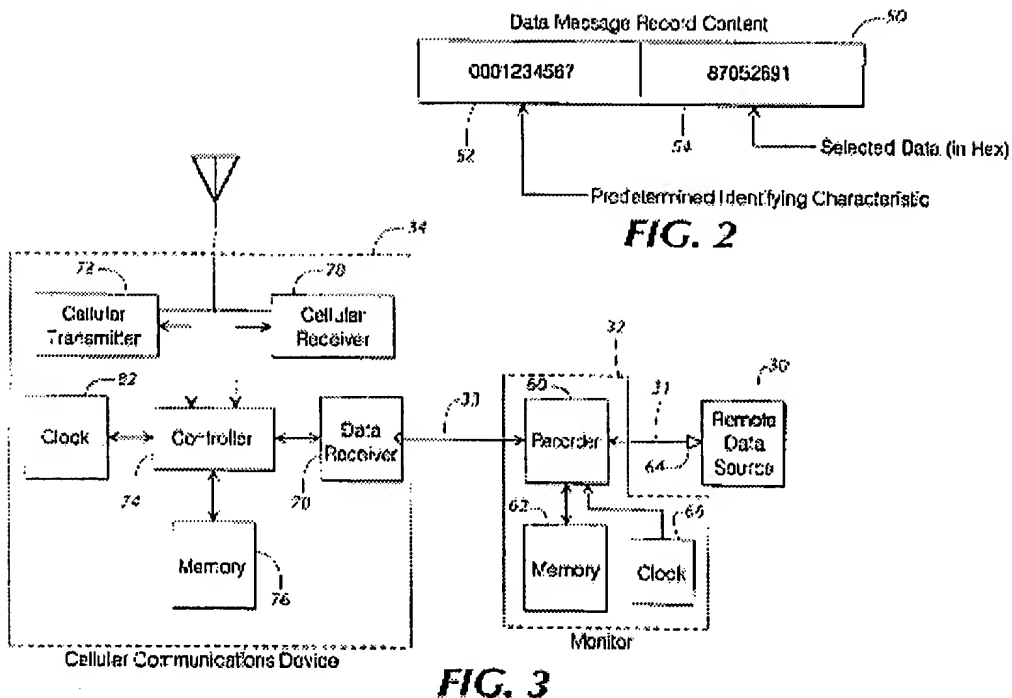
It has been held that the recitation that an element is "*capable of*" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

23. Claim 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan** in view of **Comer, et al**.

Liebenow, et al or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan** disclose all subject matter, except for one of the operation conditions is the determination of whether the transmission is occurring during peak or off-peak periods. **Comer, et al** teaches the use of one of the operation conditions is the determination of whether the transmission is occurring during peak or off-peak periods in a method of selecting a transmission system for the purpose of minimizing interference to normal control operations on the control channel, the

cellular communications device transmits the selected data during certain off-peak times of operation for the system. Hence, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to incorporate the use one of the operation conditions is the determination of whether the transmission is occurring during peak or off-peak periods as taught by Comer, et al, in the method of **Liebenow, et al** or **Shimosako** or **Dent** or **Cashman** or **O'Sullivan** in order to minimize interference to normal control operations on the control channel, the cellular communications device typically transmits the selected data during certain off-peak times of operation for the system.

OFFICE ACTION 01/05/01
7:10 PM



Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Steinbeck, et al disclose a corded cordless telephone.

Karpus, et al show an interface system for providing hands-free operation of a radio telephone and accessories.

Selin, et al teach an adapter for data transmission to and from a radio telephone.

Cina, et al show a cordless communication system for a portable computer modem.

OFFICE ACTION 01/05/01
7:10 PM

Young, et al exhibit a method of and apparatus for communicating information signals.

Shin discloses a wireless data communication system using a microphone headphone jack of a portable phone.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 703-305-4394. The examiner can normally be reached on Monday through Thursday, 9:30 to 5:30, EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **DAINIEL HUNTER** can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6306 for regular communications and 703-308-6296 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



William Cumming
Primary Patent Examiner
Washington, DC 20231
(703) 305-4394 (703) 308 6306 Fax
william.cumming@uspto.gov

A handwritten signature in black ink, appearing to read "William Cumming".

WILLIAM CUMMING
PRIMARY EXAMINER
GROUP 2600